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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,629	12/17/2003	Avery Fong	246161US2CONT	4751
22850	7590	05/12/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			TSUI, WILSON W	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/736,629	FONG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Wilson Tsui	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20060303, 20050804</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the application filed on 12/17/2003, Preliminary Amendment filed on 12/17/2003, IDS filed on 12/17/2003, IDS filed on 3/12/2004, IDS filed on 6/21/2005, IDS filed on 8/04/2005, and IDS filed on 3/3/2006.
2. Claims 1-24 are pending. Claims 1, 9, and 17 are independent claims.

### ***Specification***

3. The abstract of the disclosure is objected to because it is too long.

Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Correction is required. See MPEP § 608.01(b)

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 17-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regards to claim 17-24, for the claimed "computer program product" appears to be directed to computer data structures not explicitly embodied in a computer readable media, as it is stated in the claims to be "having a computer usable medium", thus the computer program product is not statutory. See MPEP 2106 Below:

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material *Per Se* or Computer Programs Representing Computer Listings *Per Se*

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,678,867 B2 (hereinafter '867). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons.

Claim 1 of the '867 transforms/translated between a first structured format and the second structured format, while claim 1 of the present invention translates between an *element of the* first structured description/format *to at least one element of the* second structural description.

However, it is inherent that a structured format will include at least one element, and is also indicated by Appendix D of the '867.

Additionally, claim 1 of the '867 outputs from "the map editor, a map of the translation between the first structured format, and second structured format, based on the inputting from the second system, first system, and graphical user interface into the map editor (for which the inputting includes user references as also indicated in the claim: "inputting into a map editor from the graphical user interface user preferences ..." ('867, column 32, lines 7-9). Meanwhile, claim 1 of the present invention *stores* translation information comprising at least the preferences input by the user.

However, the ability to *store* output data is well known in the art. It would have been obvious for one of the ordinary skill in the art at the time of the invention to have modified the present invention such that the output translation information is stored, as well known in the art. The combination would have allowed the present invention to implement persistency of data for backup or later use.

Claims 2-5 of the present invention are adding the same limitations as claims 2-5 of '867. Therefore, claims 2-5 of the present invention are not patentably distinguishable over claims 2-5 of '867.

Claim 6 of the present invention includes a similar limitation (falls under the scope) as indicated in claim 1 of '867. Therefore, claim 6 of the present invention is not patentably distinguishable over claim 1 of '867.

Claim 7 and 8 of the present invention include the same limitations as claim 6 of '867, since the second structured format of XML as expressed by '867 also satisfies the second structured format derived from SGML, as known in the art.

6. Claims 9-16 of the present invention, are similar to claims 1-8 of the present invention, and are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,678,867 B2 (hereinafter '867) under the same rationale.

7. Claims 17-24 of the present invention, are similar to claims 1-8 of the present invention, and are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,678,867 B2 (hereinafter '867) under the same rationale.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kutay et al (US Application: 2002/0026461, published: Feb. 28, 2002, filed: Jun. 5, 2001, EEFD: Jun. 5, 2000).

With regards to claim 1, Kutay et al teaches a method comprising:

- *Inputting, into an editor, a first structural description of a first structured format* (Fig 16A: whereas a first structural description is a 'Source DTD' is used as input for the first structured format).
- *Inputting, into the editor, a second structural description of a second structured format* (Fig 16B: whereas a second structural description is a 'Target DTD', and is used as input for the second structured format).
- *Inputting, into the editor by a user, preferences for transforming an element of the first structural description to at least one element of the second structural description* (Fig 16F: whereas, an element of the first structural description is in this case a 'AltoXML element', and the user inputs mapping preferences to map at least one element of a second structural description to the 'AltoXML element').
- *Transforming first information provided in the first structured format into second information in the second structured format based on the translation information:* whereas through the use of a transform editor, "each element of the source DTD is mapped into one element of the target DTD" (paragraphs 200-201: transform information is defined by user preferences made in a transform editor window).  
Final transformation from first structured format to second structured format is



then performed and “displayed in the target format for the user” (paragraph 0202).

However, although Kutay et al teaches using translation information for translating from source structural description to target structural description through user preferences made through the transform editor window (as explained above), Kutay et al does not expressly teach *storing* the translation information.

Yet, the ability to *store* output data is well known in the art. It would have been obvious for one of the ordinary skill in the art at the time of the invention to have modified the present invention such that the output translation information is stored, as well known in the art. The combination would have allowed Kutay et al's mapping editor to have implemented persistency of data for backup or later use.

With regards to claim 2, which depends on claim 1, Kutay et al teaches a method for *the first structured format has a Document Type Defintion (DTD) directed hierarchy*, as explained in claim 1, and is rejected under the same rationale.

With regards to claim 3, which depends on claim 1, Kutay et al teaches a method *wherein the first structured format is derived from Standard Generalized Markup Language* (whereas, the first SGML-derived structural format that was taught by Kutay et al was XML), as explained in claim 1, and is rejected under the same rationale.

With regards to claim 4, which depends on claim 3, Kutay et al teaches a method *wherein the first structured format is extensible markup language*, as explained in claim 1, and is rejected under the same rationale.

With regards to claim 5, which depends on claim 3, Kutay et al teaches a method wherein the *second structured format is a document type definition (DTD) directed hierarchy*, as explained in claim 1, and is rejected under the same rationale.

With regards to claim 6, which depends on claim 3, Kutay et al teaches a method further comprising *outputting, from the editor to a graphical user interface, a representation of a translation between the first structured format and the second structured format*: whereas, a representation of element translation is shown in a GUI as indicated by Fig 16D, reference number 1611. Also a representation of the result of the translation is also displayed as explained in paragraph 0202).

With regards to claim 7, which depends on claim 3, Kutay et al teaches a method wherein *the second structured format is derived from Standard Generalized Markup Language*: whereas, the second/target format follows the rules of SGML format (paragraph 0189).

With regards to claim 8, which depends on claim 7, Kutay et al teaches a method wherein, *the second structured format is extensible markup language*: whereas, the second structured format is presented in XML format using the XML transform editor (paragraph 0062).

With regards to claim 9, for a system performing the same method as the method in claim 1, is rejected under the same rationale.

With regards to claim 10, which depends on claim 9, for a system performing the same method as the method in claim 2, is rejected under the same rationale.

Art Unit: 2178

With regards to claim 11, which depends on claim 9, for a system performing the same method as the method in claim 3, is rejected under the same rationale.

With regards to claim 12, which depends on claim 11, for a system performing the same method as the method in claim 4, is rejected under the same rationale.

With regards to claim 13, which depends on claim 11, for a system performing the same method as the method in claim 5, is rejected under the same rationale.

With regards to claim 14, which depends on claim 11, for a system performing the same method as the method in claim 6, is rejected under the same rationale.

With regards to claim 15, which depends on claim 11, for a system performing the same method as the method in claim 7, is rejected under the same rationale.

With regards to claim 16, which depends on claim 15, for a system performing the same method as the method in claim 8, is rejected under the same rationale.

With regards to claim 17, for a computer usable medium performing the same method as the method in claim 1, is rejected under the same rationale.

With regards to claim 18, which depends on claim 17, for a computer usable medium performing the same method as the method in claim 2, is rejected under the same rationale.

With regards to claim 19, which depends on claim 17, for a computer usable medium performing the same method as the method in claim 3, is rejected under the same rationale.

With regards to claim 20, which depends on claim 19, for a computer usable medium performing the same method as the method in claim 4, is rejected under the same rationale.

With regards to claim 21, which depends on claim 19, for a computer usable medium performing the same method as the method in claim 5, is rejected under the same rationale.

With regards to claim 22, which depends on claim 19, for a computer usable medium performing the same method as the method in claim 6, is rejected under the same rationale.

With regards to claim 23, which depends on claim 19, for a computer usable medium performing the same method as the method in claim 7, is rejected under the same rationale.

With regards to claim 24, which depends on claim 23, for a computer usable medium performing the same method as the method in claim 8, is rejected under the same rationale.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Dean et al (US Application: US 2002/0152244 A1, published: Oct. 17, 2002, filed: Dec. 22, 2000): This reference teaches the mapping of a structural language and storage of mapping information using an editor.

Art Unit: 2178

- Lippert et al (US Patent: 6,626,957, issued: Sep. 30, 2003, filed: Oct 1, 1999):

This reference teaches mapping source data to translated target XML data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. T. 4/25/06  
Wilson Tsui  
Patent Examiner  
Art Unit: 2178  
April 25, 2006



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